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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,628	03/10/2004	Robert K. Larsen	03761.073/5125.1 P	4752

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EXAMINER

ROBERTS, LEZAH

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/797,628	Applicant(s) LARSEN ET AL.	
	Examiner Lezah W. Roberts	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7,9-15 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,9-15 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the Amendment filed August 7, 2006. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

All previous rejections have been withdrawn unless indicated below. New rejections are necessitated by amendment.

Claims

Claim Rejections - 35 USC § 112 – Indefiniteness (New Rejection)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Claim 2 recites the limitation the energizer comprises a basic substance. The independent claim recites the system includes potassium hydroxide, which is a basic substance therefore the recitation of "a basic substance" is indefinite. The claim needs to recite "an additional basic substance", if that is what is intended.

2) Claim 7 recites the limitation "the energizer phase includes a compound of iodine". The independent claim recites the system includes potassium iodide which is a iodine compound therefore the recitation of "compound of iodine" is indefinite and should read "an additional compound of iodine", if that is what is intended.

Claim Rejections - 35 USC § 102 – Anticipation (Previous Rejection)

1) Claims 1-2, 4, 7, 9-10, 13, 16, 18-19 and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Prussin et al. (US 3,966,090). The rejection is maintained in regards to claims 13 and 21-22. The rejection is withdrawn in regards to claims 1-2, 4, 7 and 9-10. Claims 16 and 18-19 have been canceled.

Applicant has amended the claims to recite an energizer phase comprising potassium hydroxide and potassium iodide for claims 1-2, 4, 7 and 9-10. Applicant doesn't specifically address the 102 rejection anticipated by Prussin et al. Applicant does address the reference in regards to the 103 rejection. Applicant argues Prussin is non-analogous art and all rejections based on Prussin should be withdrawn. Prussin's primary contribution to the rejection was potassium iodide and sodium iodide and claims reciting these energizers in dental bleach. This argument is not persuasive.

The argument of non-analogous art is not persuasive because there is prior art that has disclosed using the same cleaning systems for different purposes. Take for instance McKee et al. (US 2003/0118472), which teaches the peroxide and potassium iodide cleaning systems can be used to treat lens case cleaner and disinfectant, topical medical composition, industrial disinfectant, laboratory disinfectant, dental and medical

Art Unit: 1614

equipment disinfectant, acne cleaning and disinfecting treatments, insect bite disinfection, for minor skin itching and rashes and wound healing applications. The dental equipment encompasses a dental composition because the term dental encompasses surface in and out of the oral cavity. This further supports the arts of wound disinfectants and industrial disinfectants are analogous (paragraph 0055).

Johansen also discloses antimicrobial compositions comprising a peroxide source and potassium iodide. These compositions can be used as a disinfectant, e.g. in the treatment of acne, infections in the eye or the mouth, skin infections; in antiperspirants or deodorants; in foot bath salts; for cleaning and disinfection of contact lenses, hard surfaces, teeth (oral care), wounds, bruises and the like (paragraph 0231). This further support the references are analogous. Where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor involved. *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng 'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003).

Claim Rejections - 35 USC § 103 – Obviousness (Previous Rejection)

1) Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pellico (5,928,628) in view of Prussin et al. (US 3,966,090). The rejection is maintained in regards 1-2, 7, 9-15 and 21-25. Claims 3-6, 8 and 16-20 are canceled.

Applicant argues nothing in Prussin relates to dental whitening or bleaching. There would be no reason for a person working in the field of dental whitening or dental bleaching to look to a separate medical field of wound antiseptics, as the problems of wound antiseptics are not encountered when bleaching teeth. Also see the arguments above. These arguments are not persuasive.

It has been shown by the above cited references that a person working in the dental field and vice versa have looked to separate medical fields to solve problems of the one art. This is shown by ability of a composition in one art to be used for different purposes in another art. The claims also read on a dental bleaching system and does not recite the compositions are used in the oral cavity.

2) Claims 11-12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pellico (5,928,628) in view of Pellico (US 2003/0190293). The rejection is maintained.

Applicant does not address this rejection in the Remarks therefore the rejection is maintained.

Obvious-Type Double Patenting

Claims 1-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/923,502. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are coextensive because a dental whitening composition is arguably a species of a household cleaner.

Art Unit: 1614

The instant claims differ from the copending claims insofar as they recite a dental whitening composition as oppose to a dental cleaning composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-2, 7, 9-15 and 21-25 are rejected.

Claims 3-6, 8 and 16-20 are cancelled.

No claims allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lezah W. Roberts whose telephone number is 571-272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lezah Roberts
Patent Examiner
Art Unit 1614



Frederick Krass
Primary Examiner
Art Unit 1614

